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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,430	08/18/2005	Guy D. Diana	1282-P02361US01	2400

110 7590 05/29/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ROBINSON, BINTA M	

ART UNIT	PAPER NUMBER
1625	

MAIL DATE	DELIVERY MODE
05/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,430	DIANA ET AL.	
	Examiner	Art Unit	
	BINTA M. ROBINSON	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Applicant's amendment filed 2/3/09*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *10-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,7 and 8* is/are rejected.

7)☒ Claim(s) *3, 6, 9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

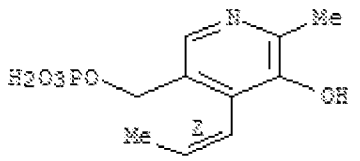
The 102 (b) rejection of claims 1 and 4 over Hcaplus 60:69598, the 102 (b) rejection of claim 7 over Maidonis et. al., the 103 (a) rejection of claims 2, 3, and 5 over Hcaplus 60:69598, the 103 (a) rejection of claim 7 over Maidonis et. al., and the 112, first paragraph rejection of claims 2-9 are rendered moot in light of applicant's amendments and remarks filed 2/3/09. Claims 10-35 are withdrawn from consideration as being drawn to the non-elected invention. The Restriction is made FINAL.

(new rejections)

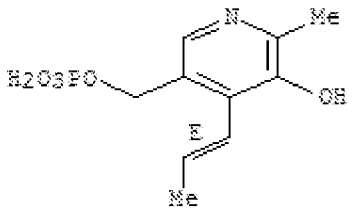
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hcaplus 1977:52064. Hcaplus 1977:52064 discloses the instant compounds,



and



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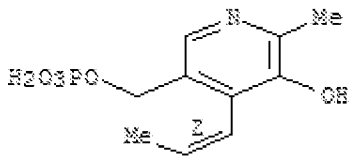
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

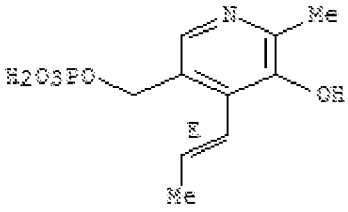
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hcaplus 1977:52064.

5. Hcaplus 1977:52064 teaches the instant compounds,



and



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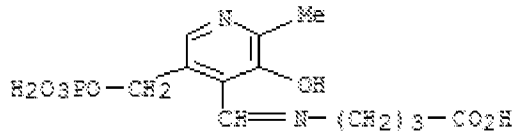
6.

The difference between the prior art compounds and the claimed compositions is the teaching of a compound mixed with a pharmaceutically acceptable carrier in the instant application versus a compound that is taught in the prior art that is not mixed with a pharmaceutically acceptable carrier. It would have been obvious to one of ordinary skill in the art to make pharmaceutical compositions out of these compounds because it is obvious to place these compounds in ethanol or another, non-toxic solvent in which they are soluble, because they are soluble in ethanol or other non-toxic solvents. Accordingly, the compositions and process of making them are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compositions and process of making them over those of the prior art compounds.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hcaplus 1989:186494. Hcaplus 1989:186494 discloses the instant compound,



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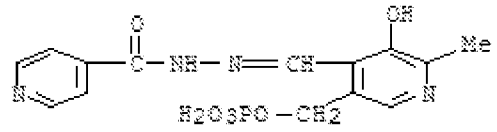
9. Claims 1, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hcaplus 1974:129778. Hcaplus 1974:129778 discloses the instant compound,



10.

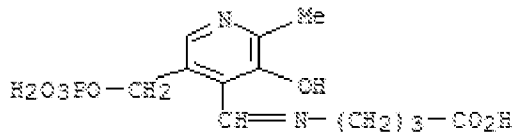
11.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2, 5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hcaplus 1989:186494.

14. Hcaplus 1989:186494 teaches the instant compound,



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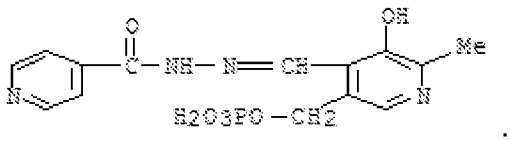
15.

The difference between the prior art compounds and the claimed compositions is the teaching of a compound mixed with a pharmaceutically acceptable carrier in the instant application versus a compound that is taught in the prior art that is not mixed with a pharmaceutically acceptable carrier. It would have been obvious to one of ordinary skill in the art to make pharmaceutical compositions out of these compounds because it is obvious to place these compounds in ethanol or another, non-toxic solvent in which they are soluble, because they are soluble in ethanol or other non-toxic solvents. Accordingly, the compositions and process of making them are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compositions and process of making them over those of the prior art compounds.

16. Claims 2, 5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hcaplus 1974:129778. .

17. Hcaplus 1974:129778 teaches the instant compound,



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18. The difference between the prior art compounds and the claimed compositions is the teaching of a compound mixed with a pharmaceutically acceptable carrier in the instant application versus a compound that is taught in the prior art that is not mixed with a pharmaceutically acceptable carrier. It would have been obvious to one of ordinary skill in the art to make pharmaceutical compositions out of these compounds because it is obvious to place these compounds in ethanol or another, non-toxic solvent

in which they are soluble, because they are soluble in ethanol or other non-toxic solvents. Accordingly, the compositions and process of making them are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compositions and process of making them over those of the prior art compounds.

19. Claims 3, 6,9 are objected to for being based on a rejected claim.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. /Binta M Robinson/
21. Examiner, Art Unit 1625

/Janet L. Andres/
Supervisory Patent Examiner, Art Unit 1625